UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,390	03/01/2002	Arnold H. Bramnick	BOC920010020	1305

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EXAMINER
KOROBOV, VITALI A

ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 March 2002*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☒ Claim(s) *11-18* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 March 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date *03/01/2002*.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This is a first Office Action on the merits of this application. Claims 1-20

are presented for examination.

Paper Submitted

2.   It is hereby acknowledged that the following papers have been received

and placed of record in the file: **Information Disclosure Statement** as received on

03/01/02 was considered.

Specification Objections

3.   Applicant is reminded of the proper language and format for an abstract of

the disclosure.

The abstract should be in narrative form and generally limited to a single

paragraph on a separate sheet within the range of 50 to 150 words. It is important that

the abstract not exceed 150 words in length since the space provided for the abstract

on the computer tape used by the printer is limited. The form and legal phraseology

often used in patent claims, such as "means" and "said," should be avoided. The

abstract should describe the disclosure sufficiently to assist readers in deciding whether

there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information

given in the title. It should avoid using phrases which can be implied, such as, "The

disclosure concerns," "The disclosure defined by this invention," "The disclosure

describes," etc.

The abstract of the disclosure is objected to because it contains 275 words,

almost twice the allowable limit. Correction is required. See MPEP § 608.01(b).

Claim Objections

4.   Claims 11-18 are objected to because of the following informalities:

Claims 11, 12 and 13 are listed as method claims dependent on claim 9. There is no

mention of any method in claim 9.

All dependent claims are objected to as having the same deficiencies as the

claims they depend from.

Appropriate correction is required.

For purposes of the instant Office Action, the Examiner assumed that said claims

11, 12 and 13 are dependent on claim 10, and the language of said claims was

changed accordingly.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

5.   Claims 19 and 20 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter – a program for a client and a

program for a transfer server.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6.   Claims 1-9, 19 and 20 are rejected under 35 U.S.C. 112, first paragraph,

as failing to comply with the enablement requirement. The claim(s) contains subject

matter which was not described in the specification in such a way as to enable one

skilled in the art to which it pertains, or with which it is most nearly connected, to make

and/or use the invention. Claims 1, 18 and 19 refer to "elements", said "elements" not

mentioned in the specification.

All dependent claims are rejected as having the same deficiencies as the claims

they depend from.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7.   Claims 2-9, 15, 17 and 18 are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention.

Claims 2-5, 15, 17, and 18 are replete with terms that render these claims

indefinite (such as "may be", "more convenient", "impractical", "unduly impeded", "large

file", "slow transmission", "fast transmission", "more conducive", "minimal interference",

"restricting" and "effectively"). These terms are relative terms which render the claims

that contain them indefinite. These terms are not defined by their respective claims, the

specification does not provide a standard for ascertaining the requisite degree, and one

of ordinary skill in the art would not be reasonably apprised of the scope of the

invention.

All dependent claims are rejected as having the same deficiencies as the claims

they depend from.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the
United States before the invention thereof by the applicant for patent, or on an international application
by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this
title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior

to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8.   Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by

the U. S. Patent 6,351,776 to O'Brien et al. (hereinafter O'Brien).

Referring to claim 1, O'Brien teaches a system for providing a file retrieval,

storage and forwarding service for a user of a data communication network, said system

comprising: a file transfer server connected to said network (Fig. 1, web server 140;

annotation to web server 140); said file transfer server communicating with said user to

receive first and second different requests from at least one workstation operated by

said user (Col. 7, lines 55-59); said file transfer server including: elements responsive to

a said first request to retrieve a data file from a source on said network identified in the

respective request (Col. 7, lines 9-13 – HTTP GET/POST requests), said source remote

from both said user workstation and transfer server (Col. 7, lines 13-16 – client requests

are redirected through DNS server to a remote location), said elements acting further to

store the retrieved file for said user (Fig. 11, a schematic and flowchart diagram of the

Internet-to-resource transfer ("Skip the Download"/"Save to My Xdrive" mode of

operation of the "Internet X:Drive"). See also col. 18, lines 13-19); elements for

confirming to said user retrieval and storage of said requested file (Fig. 11, status codes

of file transfer 1148 and 1142); and elements responsive to a said second request

issued by said user to transmit said stored file to said user (Col. 18, lines 19-22 –

subsequent download of the file by the user to his local computer at his convenience).

Referring to claim 2, O'Brien teaches a system in accordance with claim 1

wherein said first request may be issued by said user when, due to conditions at said

user's workstation, it is more convenient to said user to have said file retrieved and

stored by said file server than to download said file directly to said user's workstation

(Col. 18, lines 16-19).

Referring to claim 3, O'Brien teaches a system in accordance with claim 2

wherein said conditions at said user's workstation and the size of the requested file

make it impractical for said user to directly download said requested file to said user's

workstation (Col. 18, lines 16-19).

Referring to claim 4, O'Brien teaches a system in accordance with claim 2

wherein said conditions at said user's workstation involve execution of tasks more

important than retrieval of the requested file, which tasks would be unduly impeded by

direct downloading of the requested file to said user's workstation (Col. 18, lines 19-22).

Referring to claim 5, O'Brien teaches a system in accordance with claim 2

wherein said requested file is a large file, said user issues said first request from a first

workstation operating at a slow transmission speed that makes it impractical for said

user to directly download said requested file (Col. 18, lines 13-16 – data speeds of the

transfer vs. download speed of the client); and said user issues said second request

from a second workstation operating at a fast transmission speed more conducive to

efficient retrieval of the requested file (Col. 4, lines 1-5 – user access to X:Drive from another computer).

Referring to claim 6, O'Brien teaches a system in accordance with claim 2 wherein: said user workstation at which said first request is issued lies behind a firewall which effectively prevents transfer of data directly from said remote source to the respective workstation (Col. 7, lines 16-24 - a proxy server process prevents a direct connection between the client 102 and the other downstream resources in the X:Drive system 100), but does not prevent transfer of data from said transfer server to the same workstation (Col. 7, lines 10-14 – HTTP requests pass through firewalls).

Referring to claim 7, O'Brien teaches a system in accordance with claim 5 wherein both said transfer server and a workstation instantly operated by said user to issue said first request are behind said firewall and said remote source of data is outside said firewall (Col. 3, lines 38-44).

Referring to claim 8, O'Brien teaches a system in accordance with claim 5 wherein both said transfer server and a workstation operated by said user to issue said second request are situated behind said firewall (Col. 3, lines 38-44), and wherein said remote source of data and another workstation operated by said user to issue said first request are situated outside said firewall (Col. 4, lines 1-5).

Referring to claim 9, O'Brien teaches a system in accordance with claim 5 wherein both the transfer server and a workstation operated by said user to issue said first request are behind said firewall (Col. 3, lines 38-44), and said remote data source and another workstation operated by said user to issue said second request are outside

said firewall (Col. 4, lines 1-5. Further, a web server using a CGI, Java.RTM.-based, or

other interface transmits and retrieves TCP/IP packets or other Internet information

through a load balancer/firewall by using XML to wrap the data packets, thereby

providing flexibility with respect to a position of the firewalls in relation to the work

stations, issuing both first and second requests, and the web server and the X:Drive.

See Col. 11, lines 45-55 – XML encapsulation).

Claims 10-18 are rejected in view of the above rejection of claims 1-9. Claims 10-

18 are essentially the same as claims 1-9, except that they set forth the invention as a

method rather than a system, as do claims 1-9.

Claims 19 and 20 are rejected in view of the above rejection of claims 1-9.

Claims 19 and 20 are essentially the same as claims 1-9, except that they set forth the

invention as a computer program rather than a system, as do claims 1-9.

9.   **Examiner's note:** Examiner has cited particular columns and line
numbers in the references as applied to the claims above for the convenience of the
applicant. Although the specified citations are representative of the teachings of the art
and are applied to the specific limitations within the individual claim, other passages and
figures may apply as well. It is respectfully requested from the applicant in preparing
responses, to fully consider the references in entirety as potentially teaching all or part
of the claimed invention, as well as the context of the passage as taught by the prior art
or disclosed by the Examiner.

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Applicant is reminded that in amending in response to a rejection

of claims, the patentable novelty must be clearly shown in view of the state of the art

disclosed by the references cited and the objection made. Applicant must show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

11.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vitali Korobov whose telephone number is 571-272-7506. The examiner can normally be reached on Mon-Friday 8a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571)272-4006. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vitali Korobov
Examiner
Art Unit 2155

07/30/2005
VAK
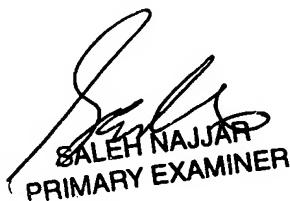
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